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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,937	12/30/2003	David B. Rhoades	RPS920030166US1	1921

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EXAMINER	
YANCHUS III, PAUL B	

ART UNIT	PAPER NUMBER
2116	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/748,937	RHOADES, DAVID B.	
	Examiner	Art Unit	
	Paul B. Yanchus	2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/20/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. How the system is shipped does not further limit claims on the system itself.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Paul, US Patent no. 5,991,875.

Regarding claim 1, Paul discloses a system for customizing a computer system comprising:

a configuration mechanism [configuration card] for storing customization information for the computer system [column 3, lines 37-45], wherein when the configuration mechanism is coupled to the computer system [column 3, lines 59-65], the computer system is configured to

retrieve during a first system boot the customization information in the configuration mechanism to customize the computer system [column 3, lines 28-35 and column 4, lines 20-25].

Claim Rejections - 35 USC § 103

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, US Patent no. 5,991,875, in view of Cepulis, US Patent no. 6,961,791.

Regarding claim 2, Paul, as described above, discloses a configuration mechanism, which is configured to be plugged into a computer system, that stores customization information for the computer system. Paul does not disclose that the configuration mechanism is a PCI adapter. However, as shown by Cepulis, PCI adapters for storing configuration information for a computer system are well known in the art [column 2, lines 28-33 and column 3, lines 55-67]. It would have been obvious to one of ordinary skill in the art to implement the Paul configuration mechanism as a well known PCI adapter to increase the compatibility of the system. One of ordinary skill in the art would be motivated to implement the Paul configuration mechanism as a well known PCI adapter to increase the compatibility of the system by enabling the configuration mechanism to be used with any computer systems that include the well known PCI bus architecture.

Regarding claim 3, Paul discloses that the configuration mechanism may be manually programmed with the customization information at a distribution site [column 5, lines 2-5].

Regarding claim 4, Paul discloses that the configuration mechanism includes at least one communication port [communications interface, column 3, lines 37-41].

Regarding claim 5, Paul is silent as to how the customization information is downloaded to the configuration mechanism. However, in order for the configuration information to be stored on the card the configuration information must be downloaded to the configuration mechanism from some sort of server device. Therefore, the configuration information in the Paul and Cepulis system is inherently downloaded from a server to the configuration mechanism via a communication port.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 6, 7 and 8 of copending Application No. 10/748,431. Although the conflicting claims are not identical, they are not patentably distinct from each other. The preamble in claims 4, 6, 7 and 8 of copending

Application No. 10/748,431 recite a method for customizing a computer system and claims 1, 2, 4 and 5 of the present application recite a system for customizing a computer system. However, claims 4, 6, 7 and 8 of copending Application No. 10/748,431 teach all of the limitations of claims 1, 2, 4 and 5 of the present application.

Claims 1, 2, 4 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6, 7, 8 and 9 of copending Application No. 10/748,630. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 6, 7, 8 and 9 of copending Application No. 10/748,630 teach all of the limitations of claims 1, 2, 4 and 5 of the present application except the limitation that the retrieving of information in the configuration mechanism takes place during a first system boot. Claims 6, 7, 8 and 9 of copending Application No. 10/748,630 are silent as to when the information is retrieved from the configuration mechanism. However, it would have been obvious to one of ordinary skill in the art to modify the system disclosed by Claims 6, 7, 8 and 9 of copending Application No. 10/748,630 to perform the retrieving of customization information in the configuration mechanism during a first system boot in order to prevent the user from having to use a computer system with an unfamiliar setup.

Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 8-12 of copending Application No. 10/748,898. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 6 and 8-12 of copending Application No. 10/748,898 teach all of the limitations of claims 1-6 of the present application except the limitation that the retrieving of information in the configuration mechanism takes place during a first system boot. Claims 6 and

8-12 of copending Application No. 10/748,898 are silent as to when the information is retrieved from the configuration mechanism. However, it would have been obvious to one of ordinary skill in the art to modify the system disclosed by Claims 6 and 8-12 of copending Application No. 10/748,898 to perform the retrieving of customization information in the configuration mechanism during a first system boot in order to prevent the user from having to use a computer system with an unfamiliar setup.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Connor, US Patent no. RE38,762, discloses a process for configuring software in a build-to-order system.

Garnett, US Patent no. 6,851,614, discloses a portable programmable data carrier for storing configuration information.

Herzi et al., US Patent no. 6,353,885, discloses a method for providing configuration information to a computer system.

Simpson et al., US Patent no. 5,404,580, discloses a removable memory means for storing user specific configuration information for a computer device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Yanchus whose telephone number is (571) 272-3678. The examiner can normally be reached on Mon-Thurs 8:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Yanchus
April 20, 2006

LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100